

BEST AVAILABLE COPY**REMARKS**

Applicants note that a Preliminary Amendment was filed in this application on March 16, 2004. According to the public PAIR system image file wrapper, this amendment was received by the USPTO. Because the Examiner's rejections are directed to claims cancelled in the Preliminary Amendment, Applicants respectfully request that the Examiner confirm that the Amendment was considered.

Upon entry of the present amendment, claims 1-10, 17-20 and 22-24 are pending. Applicants have amended claims 1, 5, and 6 to better define the claims. Applicants have added new claims 23-24 to indicate that the plant propagation material is a seed. Support for these amendments is found in the specification as originally filed at page 22, third paragraph. No new matter is presented by these amendments.

The Examiner rejected claims 1-22 under 35 USC 112, first paragraph, as lacking enablement for the entire scope of compounds embraced by formula (A). The Examiner alleges that "the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Because the functional groups on the core structure of formula (A) are many...and have different sizes, polarity and electronegativity, the activity of compounds of formula (A) would be questionable." The Examiner continues that "The predictability (*sic*) in this art is high since a small change in a functional feature could result in a drastic change in activity and such a change can also result in an opposite effect or activity. To one of ordinary skill in the art, it would be a big job to determine the effect of all of the claimed structural changes. Because of this large burden (determination of which compounds would render desired results), Examiner would like to point out that Applicant would be entitled to a subgenus of what is being claimed." Applicants respectfully traverse this rejection.

First, Applicants reiterate the confusion with respect to entry of the Preliminary Amendment. As a result, Applicants are unsure whether the present rejection is directed to the amended claim or the claim as originally presented. Applicants note, that for the claims as now pending, the specification is enabling for the scope of the claims.

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The Examiner appears to allege that the breadth of the claims renders them insufficiently enabled by the present specification. Applicants note that the specification discloses that the compounds of formula (A) are known in the art. Specifically, page 4, line 1 of the specification notes that the compounds of formula (A) are described in EP-A-580553. Canadian Patent 2,100,924, cited in the IDS filed on March 16, 2004 and considered by the Examiner, is the English-language equivalent of EP-A-580553. Thus, how to make the compounds of formula (A) is information that was known in the art. The present specification teaches how to use the claimed combination of active ingredients as an insecticide, see disclosure beginning at page 14, for example. Accordingly, the claims are fully enabled by the present disclosure and current knowledge in the art.

The Examiner rejected claims 11-16, 21 and 22 under 35 USC 112, second paragraph as being indefinite. Applicants note that these claims are now cancelled.

The Examiner rejected claims 21-22 under 35 USC 101 as lacking utility. Applicants note that these claims are no longer pending.

The Examiner rejected claims 1-10, 17 and 19 under 35 USC 103(a) as being unpatentable in light of Morie et al (JP 07224062) and Baranowski. According to the Examiner, Morie teaches an insecticidal composition comprising compounds of formula (A) and a method of controlling insects with the compositions. According to the Examiner, Morie does not teach the composition or method comprising abamectin. For this element, the Examiner relies on Baranowski, which he characterizes as teaching an insecticidal composition of abamectin and a method of controlling insects therewith. According to the Examiner, "it would have been obvious to one having ordinary skill in the art to modify the invention taught by Morie to include the abamectin taught by Baranowski. One would have been motivated to do this since each reference have (*sic*) the same utility, i.e., each reference discloses insecticidal inventions." Applicants respectfully traverse this rejection.

The Morie reference is directed to the preparation of nitroiminotetrahydrooxadiazines as insecticides, and embraces compounds falling within the scope of formula (A). The Morie reference specifically discloses the use of the active compounds for control of *Myzus persicae*. The Baranowski reference is directed to avermectins as active ingredients for pesticidal plant protection. Specifically, the Baranowski reference teaches that avermectins possess a "unique mode of action. It is

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chemical unrelated to other miticide or insecticide." Further, Baranowski teaches that abamectin is "not considered disruptive to natural predators or beneficial insects." Thus, the teaching of Baranowski is that abamectin is a selective insecticide; it does not teach the "same utility" as the Morlie reference, as alleged by the Examiner. Accordingly, there is no motivation to combine the two references.

The Examiner rejected claims 1-10, 17 and 19 under 35 USC 103(a) as being unpatentable over Matsuo (JP 08291171) and Baranowski. The Examiner alleges that Matsuo teaches an insecticidal composition comprising a compound of formula (A) and a method of controlling insects with the compound. According to the Examiner, Matsuo does not teach the composition or method comprising abamectin. For this, the Examiner relies on Baranowski, which he says teaches a method for controlling insects with abamectin. According to the Examiner, it would have been obvious to one of ordinary skill in the art to modify the invention taught by Matsuo to include the abamectin taught by Baranski since the references have the same utility. Applicants respectfully traverse.

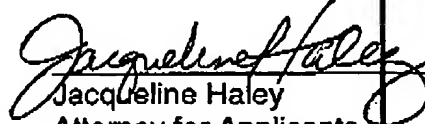
The Matsuo reference is directed to the preparation of nitroiminotetrahydrooxadiazines as insecticides, and embraces compounds falling within the scope of formula (A). The Matsuo reference specifically discloses the use of the active compounds for control of *Laodelphas striatellus* and *Nephotettix cincticeps* on rice seedlings and adult *Spodoptera litura* on sweet potato leaves. The Baranowski reference is directed to avermectins as active ingredients for pesticidal plant protection. Specifically, the Baranowski reference teaches that avermectins possess a "unique mode of action. It is chemical unrelated to other miticide or insecticide." Further, Baranowski teaches that abamectin is "not considered disruptive to natural predators or beneficial insects." Thus, the teaching of Baranowski is that abamectin is a selective insecticide; it does not teach the "same utility" as the Matsuo reference, as alleged by the Examiner. Accordingly, there is no motivation to combine the two references.

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In light of the amendments and remarks set forth herein, Applicants respectfully request withdrawal of all rejections and solicit early allowance of all of the claims.

Respectfully submitted,

Syngenta Crop Protection, Inc.
410 Swing Road
Greensboro, NC 27409
(336) 632-7547


Jacqueline Haley
Attorney for Applicants
Reg. No. 41,457

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